



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,798	10/18/2000	Xavier Paliard	PP01521.101	3092

7590 09/09/2004

Anne S Dollard
Chiron Corporation
P O Box 8097
Intellectual Property R338
Emeryville, CA 94662-8097

EXAMINER

LI, QIAN JANICE

ART UNIT	PAPER NUMBER
----------	--------------

1632

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,798

Applicant(s)

PALIARD, XAVIER

Examiner

Q. Janice Li

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,10,11 and 16-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7,10 and 30 is/are allowed.
- 6) ☒ Claim(s) 11,16-21,23-29,31 and 32 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The amendment and response filed on 6/7/04 has been entered. Claims 12-15 have been canceled. Claim 11 has been amended, and claim 32 is newly submitted. Claims 1-7, 10, 11, 16-31 are pending and under current examination.

Unless otherwise indicated, previous rejections that have been rendered moot in view of the amendment to pending claims will not be reiterated. The arguments in 6/7/04 response would be addressed to the extent that they apply to current rejection.

Priority

In the 6/7/04 response, applicants pointed to page 3 of the specification and Butcher reference in the instant provisional application as support for the priority date for BLC. However, it is noted that BLC is a specific chemokine, which was first disclosed by *Gunn et al* (Nature 1998 February). The instant provisional application 60/082,600 was filed two months after the initial disclosure of the BLC, and there is no specific reference to BLC nor teaching that BLC is capable of enhancing the efficacy of a nucleic acid viral vaccine. Page 3 of the specification of the provisional application 60/082,600 teaches general function of a chemokine i.e. causing migration of APCs/lymphocytes. Here, neither BLC nor B lymphocytes was even mentioned. Moreover, Applicants cannot rely on the *Butcher et al* reference, because it was published two-years before the discovery of BLC. ONE CANNOT DESCRIBE WHAT ONE HAS NOT CONCEIVED. See *Fiddes v. Baird*, 30 USPQ2d 1481, 1483. Accordingly, it is maintained that the priority date for

Art Unit: 1632

the subject matter (BLC) has been granted to April 22, 1999, the filing date of the PCT application.

Claim Objections

Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The prior rejection of Claims 11-29 under 35 U.S.C. 112 first paragraph, is withdrawn in view of claim amendment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1632

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11, 16-21, 25-29, 31 stand rejected under 35 U.S.C. 102(e) as being anticipated by *Garzino-Demo et al* (US 6,569,418), and the rejection applies to new claim 32.

Applicants argue that the cited patent is not a prior art to this application because BLC was not disclosed in the priority document of the cited patent, i.e. 60/069,281.

In response, this is only true with regard to BLC, which was disclosed in the priority document of the cited patent, 60/186,416, filed March 2, 2000. However, using a chemokine/a polynucleotide encoding such in general, a macrophage chemokine such as MIP and RANTES in particular, was fully disclosed in another priority document of the cited patent, i.e. provisional application 60/069,281 (e.g. § 2.3, and § 5.1-5.4), filed December 11, 1997, which predates the priority date of instantly claimed subject matter, i.e. April 22, 1998. Moreover, using a chemokine or the polynucleotide encoding and expressing a macrophage derived chemokine along with a nucleic acid viral vaccine to enhance an immune response to a viral immunogen is also fully disclosed in 60/069,281 application.

Accordingly, the cited patent is a prior art to the subject matter in claims 11, 16-21, 25-29, 31, and 32, and the rejection to these claims stands.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 23, and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Garzino-Demo et al* (US 6,569,418), in view of *Jolly et al* (US 6,297,048), for reasons of record and set forth under 35 USC § 102.

The prior rejection of Claims 11, 16, 17, 21, 25, and 27-29 under 35 U.S.C. 103(a) as being unpatentable over *Hurwitz et al* (US 5,846,546) is withdrawn in view of claim amendment.

The prior rejection of Claims 11-21 and 23-29 under 35 U.S.C. 103(a) as being unpatentable over *Hurwitz et al* (US 5,846,546) as applied above to claims 11-13, 16, 17, 21, 25, and 27-29, and in view of *DeVico et al* (US 6,214,540) is withdrawn in view of claim amendment.

The prior rejection of Claims 11-13, 16, 17, 21, 27, and 29 under 35 U.S.C. 103(a) as being unpatentable over *Chandrashekar et al* (US 6,383,774) in view of *Hurwitz et al* (US 5,846,546), is withdrawn in view of claim amendment.

Conclusion

Claims 1-7, 10, and 30 are allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Q. Janice Li** whose telephone number is 571-272-0730. The examiner can normally be reached on 9:30 am - 7 p.m., Monday through Friday, except every other Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Amy Nelson** can be reached on 571-272-0804. The fax numbers for the organization where this application or proceeding is assigned are **703-872-9306**.

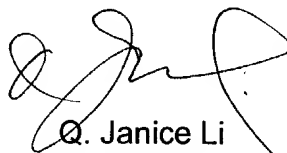
Any inquiry of formal matters can be directed to the patent analyst, **Dianiece Jacobs**, whose telephone number is (571) 272-0532.

Art Unit: 1632

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.



Q. Janice Li
Primary Patent Examiner
Art Unit 1632



August 30, 2004